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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,040	10/10/2001	Hiroki Homma	Q66535	5048

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

MCCELLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p style="text-align: center; font-weight: bold; margin: 0;">Office Action Summary</p>	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;"> Application No. 09/973,040 </td> <td style="width: 50%; padding: 2px;"> Applicant(s) HOMMA, HIROKI </td> </tr> <tr> <td style="padding: 2px;"> Examiner James S McClellan </td> <td style="padding: 2px;"> Art Unit 3627 </td> </tr> </table>	Application No. 09/973,040	Applicant(s) HOMMA, HIROKI	Examiner James S McClellan	Art Unit 3627
Application No. 09/973,040	Applicant(s) HOMMA, HIROKI				
Examiner James S McClellan	Art Unit 3627				

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 02 February 2005.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-3,5-7,9,10,12,14-18,20,21 and 23 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-3,5-7,9,10,12,14-18,20,21 and 23 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

<p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)</p> <p style="padding-left: 20px;">Paper No(s)/Mail Date _____.</p>	<p>4) <input type="checkbox"/> Interview Summary (PTO-413)</p> <p style="padding-left: 20px;">Paper No(s)/Mail Date _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p>
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DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on 2/2/05, wherein:

claims 1-3, 5-7, 9, 10, 12, 14-18, 20, 21, and 23 are pending;

claims 4, 8, 11, 13, 19, and 22 have been canceled; and

claims 1, 9, 12, 17, 18, 20, and 21 have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-7, 9, 10, 12, 14-18, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,300,880 (hereinafter "Sitnik") in view of *Official Notice*.

Regarding **claim 1**, Sitnik discloses a service system for allowing a person to listen to sound recorded in a recording medium as aural data, comprising: a first terminal (40); at least one second terminal (43) which is capable of making communication with said first terminal through a network (42, see Figure 2), said second terminal (43) being fixed in a predetermined closed area (a retail store; see column 22, line 60); and a plurality of third terminals (20; see column 1, lines 5-7, "portable receiver") each making communication with said second terminal

(43) through radio signals (see column 16, lines 45-48), each of said third terminals (20) being held by said person and being movable within said predetermined closed area (retail store); said first terminal (40) including a database (see Figure 3, "Central Database Server 40") storing aural data therein and distributing said aural data to said second terminal (43); said second terminal (43) storing therein said aural data distributed from said first terminal (40), and distributing (see Figure 3, "Local Information Distribution System 43") said aural data to each of said third terminals (20) in response to an access made by each of said third terminals (20) to said second terminal (43); each of said third terminals (20) making access to said second terminal by transmitting a signal indicative of aural data selected by a user (see column 3, lines 42-43), receiving (via receiver 25) aural data indicated by said signal, and reproducing the received aural data. The limitations of dependent **claims 2, 3, and 5** are shown in Figure 3 or disclosed in the specification (see specifically, column 22, line 55 - column 23, line 6).

Regarding **claim 9**, Sitnik discloses a service system in a shop (see column 22, line 60) selling recording mediums as set forth above in detail for claim 1. The limitations of dependent **claims 10, 12 and 14** are shown in Figure 3 or disclosed in the specification (see specifically: column 22, line 55 - column 23, line 6 and column 10, lines 51-61).

Regarding **claim 17**, Sitnik discloses a method for allowing a person to listen to sound recorded in a recording medium as aural data in a system as set forth in claim 1 and including the transmission and reproduction steps set forth in the specification. The limitations of dependent **claim 18** is shown in Figure 3 or disclosed in the specification (see specifically, column 22, line 55 - column 23, line 6).

Regarding **claim 20**, Sitnik discloses a method for allowing a person to listen to sound recorded in a recording medium as aural data in a shop selling said recorded medium as set forth in claim 1 and including the transmission and reproduction steps set forth in the specification. The limitations of dependent **claims 21 and 23** are shown in Figure 3 or disclosed in the specification (see specifically, column 22, line 55 - column 23, line 6).

Sitnik discloses all the claimed elements as set forth above but fails to explicitly disclose the use of removable memory in a mobile device, the mobile device comprises a cellular phone, and communication via bluetooth signals.

The Examiner takes Official Notice that it was old and well known at the time the invention was made for mobile devices to have removable memory, for mobile devices to be cellular phones, and communication via bluetooth signals.

U.S. Patent No. 6,771,981 (hereinafter "Zalewski") is cited as factual evidence to support the Examiner's assertion of Official Notice.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sitnik with a cell phone with removable memory and communication via bluetooth signals as was old and well known, because utilizing the customer's cell phone reduces the overhead costs required by the retail store to purchase and protect their own portable devices.

Response to Arguments

4. Applicant's arguments filed February 2, 2005 have been fully considered but they are not persuasive.

On page 10, final paragraph, Applicant argues that Zalewski merely discloses a cell phone cover for use in e-commerce and that the cover fails to provide motivation for modifying the mobile device of Sitnik. The Examiner does not concur. Before responding to Applicant's argument related to motivation, Applicant's attention is drawn to Zalewski's disclosure (see column 18, lines 1-32; see also Figure 13) which includes an example related sampling music at a retail store using a mobile device. Zalewski's music preview example is directly related to the present invention and certainly analogous to Sitnik's music previewing system. As set forth above, Zalewski teaches the use of previewing music at a retail store using a mobile phone (1330; Figure 13). Additionally, Zalewski notes that the music sample data is "downloaded" from a store server (1345) to the mobile device (1330; see column 18, lines 19-20). Zalewski discloses the use of removable modules (for example, see element 1013 "SIM" in Figure 9). Zalewski discloses that the modules include operation memory suited for saving data during use RAM (see column 1, lines 41-55). Therefore, Zalewski discloses "downloading" music sample data to the operation memory (RAM) which is included on removable SIM card (see removable SIM card in Figure 9). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to use a customer's personal

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mobile device to download music samples, because it would reduce the overhead costs incurred by each music retail store to purchase and protect their own portable devices.

On page 11, final paragraph, Applicant argues that it is not “old and well known in the art” to provide the claimed removable recording medium to a bar code reader. The Examiner does not concur. The Examiner is replacing the entire mobile device relied upon by Sitnik with the alternative mobile phone taught by Zalewski. Since Zalewski’s mobile phone serves the same purpose as Sitnik’s portable device and even includes a bar code reader (see column 18, lines 1-23), the replacement of store owned portable device with a customer owned portable device reduces the operating expenses of the store owner.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

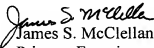
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
March 24, 2005